REMARKS

REPSONSE TO AMENDMENT

As background, a final Office Action was issued on November 27, 2001. Applicants responded to that final Office Action on January 28, 2002. At the same time, Applicants petitioned the Commissioner seeking to have the finality of the November 27, 2001, Office Action removed as inappropriate. This Petition was denied by Mr. Anthony Knight, Acting Director of Technology Center 3600, in a decision on Petition dated March 15, 2002. Applicants also received an Advisory Action dated March 20, 2002, indicating that the Response dated January 28, 2002, failed to place the application in condition for allowance.

The Examiner now attempts to rewrite history by making the following statement:

> Applicant's [*sic*] request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

If Applicants' Petition of January 28, 2002, was persuasive, and Applicants would have been timely notified of the same, then Applicants, as well as their Assignee, could have foregone the burdensome expense associated with filing the Appeal Brief dated July 22, 2002.

Accordingly, Applicants respectfully request that the Examiner clarify the record by noting that the Examiner's previous rejection, as set forth in the Office Action dated November 27, 2001, was in error, and that the Examiner realized that error after reviewing Applicants' Appeal Brief dated July 22, 2002.

REJECTIONS UNDER 35 U.S.C. § 112

The Examiner has rejected claim 23 under 35 U.S.C. § 112, fist paragraph, because the Examiner alleges that the term "100% solids tape" is not set forth in the written description in a manner that defines the tape as being "100% solids."

Reconsideration is respectfully requested. To begin with, the term "100% solids tape" is adequately supported in the written description at pages 5, line 10 and 9, line 16. Also, Applicants maintain that useful tapes are adequately disclosed at pages 7,

line 24 through page 8, line 29.

REJECTIONS UNDER 35 U.S.C. § 102

The Examiner has rejected claims 8-15, 24, and 27 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,937,640 to Tajima et al. According to the Examiner, Tajima discloses the following:

- providing a walkway pad;
- applying a solids tape to the pad; and
- applying a walkway pad to a rooftop; where the walkway pad is rubber-based; and, where the rooftop is "prepared."

Reconsideration is respectfully requested. To begin with, Tajima does not disclose a walkway pad. Instead, Tajima discloses a roofing membrane. Those skilled in the art unquestionably recognize the difference between a roofing membrane and a walkway pad. In order to assist the Examiner's understanding, Applicants have attached hereto as Exhibit A installation instructions for the Firestone Rubbergaurd Walkway Pad. This instruction guide includes a diagram of a walkway pad as well as a diagram of the walkway pad installed on top of a roofing membrane.[1] In an attempt to further distinguish the walkway pads employed in the present invention from roofing membranes as taught by Tajima, dependent claims 28-31 have been included.[2]

Tajima also does not teach the step of applying a solids tape to a walkway pad. Because Tajima does not teach a walkway pad, it logically follows that it cannot teach the step of applying a tape to a walkway pad. Nonetheless, Applicants note that Tajima does not even teach applying a tape to a roofing membrane. Instead, Tajima teaches a process for producing a multi-layered laminated bituminous roofing membrane by uniting a base sheet with a release sheet that includes compound bitumen:

> [t]here is also provided a process for producing the multi-layer laminated bituminous roofing membrane described above, which comprises the steps of:
> a. coating all or part of at least one face of the base sheet of the ordinary bituminous roofing membrane with molten bitumen;
> b. coating the releasable surface of a release sheet with a molten compound bitumen of improved tackiness including both bitumen and rubber and/or resin, and;

[1] This instructional guide has been previously provided to the Examiner by way of an Information Disclosure Statement.
[2] Support for the new dependent claims can be found at page 6, lines 19-28.

c. then uniting the surface of the compound bitumen layer on the release sheet with all or part of the bitumen coated surface of the base sheet.[3]

Tajima also does not disclose applying a walkway pad to the upper surface of a roofing membrane. Instead, Tajima teaches that the laminated roofing membrane can be applied in various configurations (See *e.g.,* Figs. 6a-9) over the top of a substrate. In this regard, it appears that the Examiner has terribly misunderstood Applicants' invention as well as the teachings of Tajima. Walkway pads are applied to a roof membrane in order to protect the membrane from damage. The membrane to which the walkway pads are applied is employed for the purpose of creating a water-impervious barrier to a rooftop. The walkway pads do not create this water impervious barrier. As mentioned above, they simply serve to protect the membrane.

In contradistinction, Tajima is concerned with creating a water impervious barrier to a rooftop. The materials that Tajima employs include bituminous or bitumen-based membranes. These membranes are conventionally applied in long rolls of membrane[4], and it is common to overlap the membranes and seal the overlapping surfaces thereof. As Tajima describes, these overlapping membranes are conventionally welded together using heat.[5] It appears that the advance in technology offered by Tajima is the elimination of the welding step.[6] Apparently this is accomplished by using a laminate membrane wherein one of the laminate layers include a compound bitumen with improved tackiness.[7]

Applicants' method solves an entirely different problem. This problem includes unpredictable adhesion between the roofing membrane and the walkway pad as well as the labor intensive installation that is required with prior art walkway pads. In the prior art, the walkway pads did not carry an adhesive and therefore the adhesive had to be applied to the walkway pad within the field, *i.e.,* on the rooftop.

Inasmuch as anticipation requires that a single reference disclose each and every element of a claimed invention, Applicants' maintain that Tajima does not anticipate the claimed invention on several grounds. Additional distinguishing factors include those recitations of newly added dependent claims 32-33. As set forth in claim

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[3] Column 3, lines 5-21.
[4] *See* U.S. Patent No. 3,937,640, Figs. 1 and 2.
[5] *Id* at Column 2, lines 21-25.
[6] *Id* at Column 2, lines 57-63.
[7] *Id* at Column 3, lines 1-24.

32 the walkway pads are rubber-based.[8] In contradistinction, Tajima is concerned with asphaltic or bitumen compounds. Further, as set forth in claim 33, the membranes to which the walkway pads of the present invention are applied are rubber-based. [9] In contradistinction, Tajima is concerned with adhering various asphaltic materials or membranes to one another.

REJECTIONS UNDER 35 U.S.C. § 103

The Examiner has rejected claims 1-7 under 35 U.S.C. § 103 as being unpatentable over Tajima. The Examiner believes that Tajima discloses the basic claimed method except for the step of applying force, but believes that it would have been obvious for one of ordinary skill in the art to apply force in order to increase surface adhesion and ensure attachment between the pads and the roofing membranes.

Reconsideration is respectfully requested. Without commenting on whether the application of force would have been obvious or not, Applicants maintain that the claimed invention is patentable over Tajima because, as noted above, Tajima fails to disclose many characteristics of the claimed invention. Accordingly, the numerous distinctions noted above are likewise incorporated herein for purposes of responding to this obviousness rejection.

The Examiner has also rejected claims 16-23 under 35 U.S.C. § 103 as being unpatentable over Tajima. According to the Examiner, Tajima discloses the basic claimed method for the step of delivering the walkway pads, but nonetheless believes that the invention is obvious.[10] Without commenting on whether the step of delivering the walkway pads would have been obvious or not, Applicants maintain that the claimed invention is patentable over Tajima because, as noted above, Tajima fails to disclose many characteristics of the claimed invention. Accordingly, the numerous distinctions noted above are likewise incorporated herein for purposes of responding to this obviousness rejection.

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[8] Written description page 6, lines 19-28, and page 8, lines 20-28.
[9] Support at page 10, line 26 of the written description.
[10] The Office Action appears to be in error inasmuch as the Examiner has made the statement "it would have been obvious to one having ordinary skill in the art at the time the invention was made that a force to be applied to deliver the pads . . . Office Action, page 5.

CONCLUSION

In view of the foregoing amendments and arguments presented herein, the Applicants believe that they have properly set forth the invention and accordingly, respectfully requests the Examiner to reconsider the rejections provided in the last Office Action. A formal Notice of Allowance of claims 1-4, 6-24, and 27-33 is earnestly solicited. Should the Examiner care to discuss any of the foregoing in greater detail, the undersigned attorney would welcome a telephone call.

The Commissioner is specifically authorized to charge Deposit Account No. 06-0925 in the amount of $108.00 for the payment of fees associated with the addition of new claims. In the event that an additional fee is due or that any amount should be credited, the Commissioner is authorized to charge any additions fees or credit any overpayment to Deposit Account No. 06-0925.

Respectfully submitted,

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